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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/681,574	10/08/2003	Gary Roger Miller	01282US (EKC 90035)	6831
1333	7590	09/01/2005	EXAMINER	
BETH READ PATENT LEGAL STAFF EASTMAN KODAK COMPANY 343 STATE STREET ROCHESTER, NY 14650-2201			LE, HOA VAN	
			ART UNIT	PAPER NUMBER
			1752	
DATE MAILED: 09/01/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/681,574

Applicant(s)

MILLER ET AL.

Examiner

Hoa V. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-72 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-25, 27-36 and 72 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Continuation of Disposition of Claims: Claims withdrawn from consideration are 9 and 26 being related non-elected species and claims 37-71 are related to non-elected inventions.

This is in response to Papers filed on 24 June 2005.

I. The amendment filed 24 June 2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

(1) It is fine and understandable to change from “weak” to ---first--- on page 9, lines 25-29 of the specification.

(2) It is also fine and understandable to change from “strong” to second” on page 9, lines 18-20 of the specification.

(3) There is new matter with respect to “third” in claims 27-32.

Applicant is required to cancel the new matter in the reply to this Office Action.

II. Claims 27-32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

(1) It is fine and understandable to change from “weak” to ---first--- on page 9, lines 25-29 of the specification.

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(2) It is also fine and understandable to change from “strong” to second” on page 9, lines 18-20 of the specification.

(3) There is new matter with respect to “third” in claims 28-32.

III. Claims 27-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(1) It is fine and understandable to change from “weak” to ---first--- on page 9, lines 25-29 of the specification. The language “further” in claim 27 and its dependent claims 28-32 is not correct and improper since claim 1 with “weak” or ---first--- as disclosed already includes those in claims 27-32 and does not have “third”.

IV. Claims 1-8, 10-24, 27-36 and 72 with respect to the elected and applied species are rejected under 35 U.S.C. 102(e) as being anticipated by Aoshima (6,740,468).

Aoshima discloses and teaches a combined chemical ingredients composition for developing soft portions of an exposed photolithographic plate precursor having a pH solution of from 9.0 to 13.5 and comprising a sufficient

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amount of one or more alkaline agents including the elected species of sodium hydroxide and (up to 1 wt% of diethanolamine on col.26:61-63) to provide a pH solution of from 9.0 to 13.5, up to 10 wt% of a dispersing agent and up to 5 wt% of an organic solvent including the elected 1-phenoxyethanol. Please especially see col.25:22-50, 26:48-50 and 61 to 27:63, 28:26-39, 29:35-39, 34:46-54, 35:10-19 and 39:64 to 40:6.

The product-by-process in the claims have little value in the above applied statutory.

In claim 5, the comparative language “greater” has and is given no value in a claimed single material (composition). It would be given full value in a method for comparison of two materials.

Aoshima does not specify the “conductivity” functional property in his aqueous composition as that in claim 5. Since Aoshima aqueous composition contains strong charge ions, such as Na^+ and OH^- , at the level of one skilled in the art Aoshima aqueous composition would has a strong conductivity. For a functional property of a material, it is allowed to request applicants to provided a convincing evidence to the contrary in accordance with the authority states in *In re Schreiber*, 44 USPQ2d, 1429.

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Aoshima does not specify the “K_b...” functional property as that in claims 12 and 72. Since Aoshima composition contains strong base, such as NaOH, at the level of one skilled in the art NaOH would have “K_b...” functional property in the claim. For a functional property of a material, it is allowed to request applicants to provide a convincing evidence to the contrary in accordance with the authority states in *In re Schreiber*, 44 USPQ2d, 1429.

Aoshima does not specify the “K_b...” functional property as that in claims 12 and 72. Since Aoshima composition contains weak base, such as diethanolamine, at the level of one skilled in the art diethanolamine would have “K_b...” functional property in the claim. For a functional property of a material, it is allowed to request applicants to provide a convincing evidence to the contrary in accordance with the authority states in *In re Schreiber*, 44 USPQ2d, 1429.

In claims 34, 35, 36 the comparative language “higher than” has and is given no value in a claimed single material (composition). It would be given full value in a method for comparison of two materials.

In claims 34, 35, 36 the processing step of use of “...it is to be added” embodiment has and is given no value in any material (composition) claim. It would be given full value in a method of use.

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Since Aoshima reasonably discloses and teaches the claimed embodiments and the claimed embodiments are reasonably the same property as those in the applied compositions as clearly pointed out and set forth above, the above claims are found to be anticipated by. For a functional property of the materials, it is allowed to request applicants to provided a convincing evidence to the contrary in accordance with the authority states in In re Schreiber, 44 USPQ2d, 1429.

Applicant's arguments filed 24 June 2005 have been fully considered but they are not persuasive.

Applicants' arguments with respect to a product-by- process have no value in the above applied statute. The patentability is on single final product or single material or composition. It would be given full value in a process of making a product-by- process as urged.

V. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over.

Aoshima (6,740,468) considered in view of Miller et al (5,466,559).

Aoshima discloses and teaches a combined chemical ingredients composition for developing soft portions of an exposed photolithographic plate precursor having a pH solution of from 9.0 to 13.5 and comprising a sufficient amount of one or more alkaline agents including the elected species of sodium hydroxide and (up to 1 wt% of diethanolamine on col.26:61-63) to provide a pH solution of from 9.0 to 13.5, up to 10 wt% of a dispersing agent and up to 5 wt% of an organic solvent including the elected 1-phenoxyethanol. Please especially see col.25:22-50, 26:48-50 and 61 to 27:63, 28:26-39, 29:35-39, 34:46-54, 35:10-19 and 39:64 to 40:6.

The product-by-process of making in the claims have little value in the above applied statutory. The patentability is on the final product in the absence of convincing evidence on or for the record that a final product made by the claimed process would be another patentably distinct product.

In claim 5, the comparative language "greater" has and is given no value in a claimed single material (composition). It would be given full value in a method for comparison of two materials.

Aoshima does not specify the "conductivity" functional property in his aqueous composition as that in claim 5. Since Aoshima aqueous composition contains strong charge ions, such as Na^+ and OH^- , at the level of one skilled in the

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art Aoshima aqueous composition would have a strong conductivity. For a functional property of a material, it is allowed to request applicants to provide a convincing evidence to the contrary in accordance with the authority states in *In re Schreiber*, 44 USPQ2d, 1429.

Aoshima does not specify the “K_b...” functional property as that in claims 12 and 72. Since Aoshima composition contains strong base, such as NaOH, at the level of one skilled in the art NaOH would have “K_b...” functional property in the claim. For a functional property of a material, it is allowed to request applicants to provide a convincing evidence to the contrary in accordance with the authority states in *In re Schreiber*, 44 USPQ2d, 1429.

Aoshima broadly disclose, teach and suggest the use of an “alkyl sulfate salt” surfactant on col.27:27 but fails to specify sodium octyl sulfate as elected. Miller et al at col.5:57-64 and 15:23 is cited to show the known selection and use of the elected surfactant for the desired advantage of reducing surface tension, good and fast development.

Aoshima does not specify the “K_b...” functional property as that in claims 12 and 72. Since Aoshima composition contains weak base, such as diethanolamine, at the level of one skilled in the art diethanolamine would have “K_b...” functional property in the claim. For a functional property of a material, it

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is allowed to request applicants to provided a convincing evidence to the contrary in accordance with the authority states in In re Schreiber, 44 USPQ2d, 1429.

In claims 34, 35, 36 the comparative language “higher than” has and is given no value in a claimed single material (composition). It would be given full value in a method for comparison of two materials.

In claims 34, 35, 36 the processing step of use of “...it is to be added” embodiment has and ids given no value in any material (composition) claim. It would be given full value in a method of use.

Since the above references are all related to photolithographic developers, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use or cite sodium octyl sulfate from Miller et al in Aoshima developers for a reasonable expectation of obtaining reduction surface tension, goad and fast development as disclosed, taught, suggested and obtained in Walls et al.

VI. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 1-8, 10-25, 27-30, 32-36 and 72 are rejected under 35 U.S.C. 102(b) as being anticipated by Miller et al (5,466,559).

Miller et al disclose and teach a combined chemical ingredients composition for developing soft portions of an exposed photolithographic plate precursor having a pH solution of from 8-12 and comprising a sufficient amount of the elected species of sodium hydroxide and potassium carbonate, up to 15 wt% of the elected sodium octyl sulfate and up to 7 wt% of the elected 1-phenoxyethanol. Please especially see col.5:43 to 6:11, 7:33-39, 44-52 and 63, 8:23-55 and 15:17-26.

The product-by-process in the claims have little value in the above applied statutory.

In claim 5, the comparative language "greater" has and is given no value in a claimed single material (composition). It would be given full value in a method for comparison of two materials.

Miller et al do not specify the "conductivity" functional property in his aqueous composition as that in claim 5. Since Miller et al aqueous composition contain strong charge ions, such as Na^+ and OH^- , at the level of one skilled in the art Miller et al aqueous composition would have a strong conductivity. For a functional property of a material, it is allowed to request applicants to provide a

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convincing evidence to the contrary in accordance with the authority states in *In re Schreiber*, 44 USPQ2d, 1429.

Miller et al do not specify the “K_b...” functional property as that in claims 12 and 72. Since Miller composition contain strong base, such as NaOH, at the level of one skilled in the art NaOH would has “K_b...” functional property in the claim. For a functional property of a material, it is allowed to request applicants to provided a convincing evidence to the contrary in accordance with the authority states in *In re Schreiber*, 44 USPQ2d, 1429.

Miller et al do not specify the “K_b...” functional property as that in claims 12 and 72. Since Miller et al composition contain weak base, such as diethanolamine, at the level of one skilled in the art diethanolamine would has “K_b...” functional property in the claim. For a functional property of a material, it is allowed to request applicants to provided a convincing evidence to the contrary in accordance with the authority states in *In re Schreiber*, 44 USPQ2d, 1429.

In claims 34, 35, 36 the comparative language “higher than” has and is given no value in a claimed single material (composition). It would be given full value in a method for comparison of two materials.

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In claims 34, 35, 36 the processing step of use of "...it is to be added" embodiment has and is given no value in any material (composition) claim. It would be given full value in a method of use.

Since Miller et al reasonably disclose and teach the claimed embodiments and the claimed embodiments are reasonably the same property as those in the applied compositions as clearly pointed out and set forth above, the above claims are found to be anticipated by. For a functional property of the materials, it is allowed to request applicants to provide a convincing evidence to the contrary in accordance with the authority states in *In re Schreiber*, 44 USPQ2d, 1429.

VI. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wall et al (5,316,892) considered in view of Aoshima (6,740,468).

Miller et al disclose and teach a combined chemical ingredients composition for developing soft portions of an exposed photolithographic plate precursor having a pH solution of from 8-12 and comprising a sufficient amount of the

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elected species of sodium hydroxide and potassium carbonate, up to 15 wt% of the elected sodium octyl sulfate and up to 7 wt% of the elected 1-phenoxyethanol.

Please especially see col.5:43 to 6:11, 7:33-39, 44-52 and 63, 8:23-55 and 15:17-26.

The product-by-process of making in the claims have little value in the above applied statutory. The patentability is on the final product in the absence of convincing evidence on or for the record that a final product made by the claimed process would be another patentably distinct product.

In claim 5, the comparative language “greater” has and is given no value in a claimed single material (composition). It would be given full value in a method for comparison of two materials.

Miller et al do not specify the “conductivity” functional property in his aqueous composition as that in claim 5. Since Miller et al aqueous composition contain strong charge ions, such as Na^+ and OH^- , at the level of one skilled in the art Miller et al aqueous composition would has a strong conductivity. For a functional property of a material, it is allowed to request applicants to provided a convincing evidence to the contrary in accordance with the authority states in In re Schreiber, 44 USPQ2d, 1429.

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Miller et al do not specify the “K_b...” functional property as that in claims 12 and 72. Since Miller et al composition contain strong base, such as NaOH, at the level of one skilled in the art NaOH would have “K_b...” functional property in the claim. For a functional property of a material, it is allowed to request applicants to provide a convincing evidence to the contrary in accordance with the authority states in *In re Schreiber*, 44 USPQ2d, 1429.

Miller et al do not specify the “K_b...” functional property as that in claims 12 and 72. Since Miller et al composition contain weak base, such as diethanolamine, at the level of one skilled in the art diethanolamine would have “K_b...” functional property in the claim. For a functional property of a material, it is allowed to request applicants to provide a convincing evidence to the contrary in accordance with the authority states in *In re Schreiber*, 44 USPQ2d, 1429.

Miller et al do not specify the elected diethanolamine as that in claim 31. Aoshima at col.25:47 and 26:61-63 is cited to show the known use of diethanolamine to provide an alkalinity and permeability.

In claims 34, 35, 36 the comparative language “higher than” has and is given no value in a claimed single material (composition). It would be given full value in a method for comparison of two materials.

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In claims 34, 35, 36 the processing step of use of "...it is to be added" embodiment has and is given no value in any material (composition) claim. It would be given full value in a method of use.

Since the above references are all related to photolithographic developers, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use or cite diethanolamine from Aoshima in Miller et al developers for a reasonable expectation of obtaining alkalinity and permeability as disclosed, taught, suggested and obtained in Aoshima.

VII. Miller et al (5,466,559) have about the same teachings and suggestions as those in above applied Miller et al. it is cumulative.

VIII. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332. The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

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Applicants may file a paper by (1) fax with a central facsimile receiving number 703-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
29 August 2005.

HOA VAN LE
PRIMARY EXAMINER

A handwritten signature in black ink that reads "Hoa Van Le". The signature is written in a cursive, flowing style.